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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,078	10/05/2000	David Moir Archibald	4481-031	7765

7590

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EXAMINER

KADING, JOSHUA A

ART UNIT

PAPER NUMBER

2661

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/679,078

Applicant(s)

ARCHIBALD, DAVID MOIR

Examiner

Joshua Kading

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date Z.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

5       The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to  
10   comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

15       In regard to claims 1 and 12, applicant discloses "...selecting third messages including an identification related to an end user of said data item and a call identifier; and using said selected third messages to establish a correlation between the first and second bearer channel identifications" and "...a third selector for selecting third messages including an identification related to an end user of said data item and a call  
20   identifier; and a correlator for establishing a correlation between the first and second bearer channel identifications in accordance with said selected third messages." How are the third messages used to correlate the first and second bearer channel identifications? Where do the third messages come from? Applicant discloses a method and apparatus for "establishing a correlation between the contents of signalling  
25   messages" but does not explain how this is done in either claims 1 or 12.

Claims 5-6 are rejected for the same reasons as claim 1 because of their dependence on claim 1.

5           In regard to claims 2 and 13, applicant discloses "...selecting third messages including an identification related to an end user of said data item and packet network address information; selecting fourth messages including packet network address information and a transaction identifier; and using said selected third and fourth messages to establish a correlation between the first and second bearer channel identifications" and "...a third selector for selecting third messages including an identification related to an end user of said data item and packet network address information; a fourth selector for selecting fourth messages including packet network address information and a transaction identifier; and a correlator for establishing a correlation between the first and second bearer channel identifications in accordance with said selected third and fourth messages." How are the third and fourth messages used to correlate the first and second bearer channel identifications? Where do the third and fourth messages come from? Applicant discloses a method and apparatus for "establishing a correlation between the contents of signalling messages" but does not explain how this is done in either claims 2 or 13.

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Claims 3, 7, and 15-17 are rejected for the same reasons as claim 2 because of their dependence on claim 2.

As discussed with Allan Lowe on 1 June 2004 regarding the incompleteness of amended claim 8, the missing portion of amended claim 8 is to take the same form as the original claim 8, as such amended claim 8 is treated with the missing portion in  
5 mind. Applicant should add the missing portion in any future amendments.

In regard to claims 8 and 14, applicant discloses "...establishing a correlation between first and second messages for which the elapsed time is below a predetermined threshold, and thus between the first and second bearer channel identifications" and "...a correlator for establishing a correlation between first and  
10 second messages for which the elapsed time is below a predetermined threshold, and thus between the first and second bearer channel identifications." How does the correlator establish a correlation between the first and second messages? How is the correlation between the first and second messages established? Applicant discloses a method and apparatus for "establishing a correlation between the contents of signalling  
15 messages" but does not explain how this is done in either claims 8 or 14.

Claims 9-10 are rejected for the same reasons as claim 8 because of their dependence on claim 8.

20 As pointed to by applicant, page 6, lines 7-16 describe the place in the specification where the "correlating" using different messages is disclosed. Although

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applicant is correct that page 6, lines 7-16 talk about correlating, they do not satisfy the enablement requirement set forth in 35 U.S.C. 112 first paragraph.

In addition, applicant is correct that the claims do not need to enable the invention, but the specification does; and page 6, lines 7-16 (and further lines 17-21),  
5 although more specific in their definitions of the components of the channels and messages than the claims, does not describe how the messages are used to correlate other messages. It simply states that certain message types are used to correlate the messages (see lines 10-12 as an example). This does not describe how the correlation is carried out according to applicant's intended invention.

10 In addition, it is not clear to one with ordinary skill in the art how to make and/or use the invention based upon applicant's specification. If applicant feels this is not the case, the applicant is invited to show how the invention, according to the specification (specifically page 6, lines 7-16), could be made and/or used by someone with ordinary skill in the art.

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### ***Response to Arguments***

All claim objections for the previous Office Action dated 6 January 2004 have been withdrawn in light of applicant's amended claims.

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The 35 U.S.C. 112 second paragraph rejections from the previous Office Action dated 6 January 2004 have been withdrawn in light of applicant's amended claims.

Applicant's arguments filed 13 April 2004 have been fully considered but they are not persuasive. See above remarks for the 35 U.S.C. 112 first paragraph rejections for claims 1-17.

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***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within  
10 TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later  
15 than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Kading whose telephone number is (703) 305-0342. The examiner can normally be reached on M-F: 8:30AM-5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas Olms can be reached on (703) 305-4703. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

- 5 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joshua Kading  
Examiner  
Art Unit 2661

10 June 8, 2004



**KENNETH VANDERPUYE**  
**PRIMARY EXAMINER**